

REMARKS

I. Introduction

Claims 1-43 are pending in the application. Claims 1, 6-7, 31, and 39 are independent. Claim 8 stands objected to, and all claims stand rejected. In particular:

(A) claims 39-43 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2002/0087413 (hereinafter “Mahaffy”);

(B) claims 7-8, 17, 19-22, and 25-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,324,520 (hereinafter “Walker”) in view of U.S. Patent No. 6,606,602 (hereinafter “Kolls”);

(C) claims 1-4, 6, and 9 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of “PTS: Vending Machine Refund System” (hereinafter “PTS”);

(D) claims 5 and 10 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of U.S. Patent No. 7,286,901 (hereinafter “Whitten”);

(E) claims 11-15, 18, 23-24, and 30 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten;

(F) claim 16 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten, in further view of PTS; and

(G) claims 31-38 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of U.S. Patent Application Publication No. 2002/0099662 (hereinafter “Joshi”).

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner’s Objection

Claim 8 continues to stand object to for allegedly failing to further limit the claim upon which it depends. In response to Applicants’ previous arguments on this point, the

Examiner asserts:

that Claim 8 positively recites “receiving the input from the customer.” Claim 7 in which claim 8 depends from positively recites the same limitation by stating “receiving...from a customer, a request for a product to be dispensed from the vending machine” (i.e. an input).

Office Action, pg. 31, lines 1-5; emphasis added.

Applicants agree that claim 8 positively recites “receiving the input from the customer”. Applicants respectfully note, however, that the Examiner misinterprets the language of claim 7.

Claim 7 does indeed recite the receiving of “a request” from the customer (in the first limitation recited). Contrary to the Examiner’s assumption, however, this “request” is **not the same as** “the input” recited in claim 8. Instead, “the input” referenced by claim 8 specifically refers to the “input” recited in the second limitation recited in claim 7. Namely, the “input” from which it is determined that a customer service issue exists.

The Examiner’s current interpretation of the language of claim 7 is simply not reasonable in light of the specification as-filed, much less of the language recited within claim 7.

At least for these reasons, Applicants respectfully request that the objection to claim 8 be **withdrawn**.

III. The Examiner’s Rejections

A. 35 U.S.C. §102(b) – Mahaffy

Claims 39-43 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Mahaffy. Applicants traverse this ground for rejection as follows.

1. **The Examiner has failed to show how the reference teaches or suggests: receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of**

product, an indication of a malfunction of the vending machine that has occurred with respect to the identified transaction

Applicants respectfully assert that the Examiner has failed to show how Mahaffy teaches or suggests limitations of claims 39-43. For example, the Examiner has failed to show how Mahaffy teaches or suggests *receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of product, an indication of a malfunction of the vending machine that has occurred with respect to the identified transaction.*

The Examiner responds to Applicants' previous arguments regarding the above-quoted limitation and Mahaffy, for which Applicants respectfully thank the Examiner. Office Action, pg. 31, last paragraph to pg. 32, line 9. The Examiner, however, while admitting that Mahaffy does not teach or suggest transmitting vending machine *malfunction* information, alleges that because Mahaffy describes a vending machine that transmits *something*, a vending machine that transmits *anything* is deemed obvious. In particular, the Examiner alleges that the type of indication transmitted "holds little patentable weight in the method claim." *Id.*, at pg. 32, lines 4-5. The Examiner goes on to allege that the "type of indication does not affect the method steps claimed" and that Mahaffy is "fully capable" of performing the above-quoted limitation. *Id.*, at pg. 32, lines 5-9.

Initially, Applicants respectfully note that the Examiner's argument is equivalent to an admission that while Mahaffy does not teach or suggest the above-quoted limitation, the above-quoted limitation would, for some reason (albeit no reason provided by the Examiner), be obvious. Accordingly, the Examiner appears to have rejected claims 39-43 under improper grounds. As Mahaffy clearly does not teach or suggest the above-quoted limitation as claimed, the §102(b) ground for rejection of claims 39-43 cannot stand.

Applicants also respectfully note that the Examiner is not at liberty to read limitations out of the claim or attribute more or less "weight" to various limitations of a claim. The claim must be examined as a whole and examined for what it recites. If by "weight" the Examiner meant to imply that the particular limitation appears obvious to

the Examiner, then the Examiner should support an obviousness ground for rejection with some argument and the requisite substantial evidence – neither of which has yet been set forth on the record.

Accordingly, at least for these reasons and at least because the Examiner has failed to show how Mahaffy teaches or suggests receiving, by the vending machine and after at least one of the receiving of the indication of the request for the unit of product and the receiving of the indication of the payment for the requested unit of product, an indication of a malfunction of the vending machine that has occurred with respect to the identified transaction, the Examiner has failed to establish a *prima facie* case that Mahaffy anticipates any of claims 39-43.

Applicants therefore respectfully request that this §102(b) ground for rejection of claims 39-43 be withdrawn.

B. 35 U.S.C. §103(a) – Walker, Kolls

Claims 7-8, 17, 19-22, and 25-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Kolls. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 7-8, 17, 19-22, and 25-29 at least because the Examiner has provided no

argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 7-8, 17, 19-22, and 25-29

Applicants therefore respectfully request that these §103(a) rejections of claims 7-8, 17, 19-22, and 25-29 be withdrawn.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner’s unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Kolls to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 7-8, 17, 19-22, and 25-29 should therefore be **withdrawn**.

C. 35 U.S.C. §103(a) – Walker, PTS

Claims 1-4, 6, and 9 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 1-4, 6, and 9 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the

Examiner has failed to set forth a *prima facie* case for obviousness of claims 1-4, 6, and 9.

Applicants therefore respectfully request that these §103(a) rejections of claims 1-4, 6, and 9 be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and PTS to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 1-4, 6, and 9 should therefore be **withdrawn**.

D. 35 U.S.C. §103(a) – Walker, PTS, Whitten

Claims 5 and 10 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of Whitten. Claims 5 and 10 are believed patentable at least for depending upon patentable base claims (*i.e.*, claims 1 and 7, respectively) and at least for the reasons described in relation thereto herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims **5** and **10** at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **5** and **10**.

Applicants therefore respectfully request that these §103(a) rejections of claims **5** and **10** be withdrawn.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be

summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and PTS and Whitten to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 5 and 10 should therefore be withdrawn.

E. 35 U.S.C. §103(a) – Walker, Whitten

Claims 11-15, 18, 23-24, and 30 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten. Claims 11-15, 18, 23-24, and 30 are believed patentable at least for depending upon patentable a base claim (*i.e.*, claim 7) and at least for the reasons described in connection therewith herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 11-15, 18, 23-24, and 30 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 11-15, 18, 23-24, and 30.

Applicants therefore respectfully request that these §103(a) rejections of claims 11-15, 18, 23-24, and 30 be withdrawn.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner’s unsupported conclusory statement that it would have been

obvious to combine and/or modify Walker and Whitten to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 11-15, 18, 23-24, and 30 should therefore be **withdrawn**.

F. 35 U.S.C. §103(a) – Walker, Whitten, PTS

Claim 16 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Whitten, in further view of PTS. Claim 16 is believed patentable at least for depending upon a patentable base claim (*i.e.*, claim 7) and at least for the reasons described in connection therewith herein. Applicants further traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for claim 16 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on claim 16.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claim. Applicants respectfully note that the

Examiner's opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claim 16.

Applicants therefore respectfully request that this §103(a) rejection of claim 16 be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker, Whitten, and PTS to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claim 16 should therefore be **withdrawn**.

G. 35 U.S.C. §103(a) – Walker, Joshi

Claims 31-38 stand rejected under 35 U.S.C. §103(a) as being allegedly

unpatentable over Walker in view of Joshi. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 31-38 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 31-38.

Applicants therefore respectfully request that these §103(a) rejections of claims 31-38 be withdrawn.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Joshi to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 31-38 should therefore be **withdrawn**.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement therewith.

If there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-438-6867 or via e-mail at cfincham@finchamdowns.com, at the Examiner's convenience.

V. Petition for Extension of Time to Respond and Fees

While no fees are believed to be due at this time, please charge any fees that may be required for this Response to Applicants' Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Response timely, and please charge any fee for such an extension to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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